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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,435	05/08/2000	JUERGEN HAERER	H3174PCT/US	2312

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HENKEL CORPORATION  
2500 RENAISSANCE BLVD  
STE 200  
GULPH MILLS, PA 19406

EXAMINER

DOUYON, LORNA M

ART UNIT	PAPER NUMBER
1751	12

DATE MAILED: 08/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

(17) 12

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/446,435	HAERER ET AL.	
	Examiner	Art Unit	
	Lorna M. Douyon	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 03 June 2002.
- 2a) This action is FINAL.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 21-33 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 21-33 and 36-44 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

<ol style="list-style-type: none"> <li>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</li> <li>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.</li> </ol>	<ol style="list-style-type: none"> <li>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.</li> <li>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</li> <li>6)<input type="checkbox"/> Other: _____.</li> </ol>
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1. This action is responsive to the amendment filed on June 3, 2002.
2. The cancellation of claims 34-35 is acknowledged. Claims 21-33 and 36-44 are pending.
3. The abstract of the disclosure stands objected to because it need not recite "The invention relates to". Correction is required. See MPEP § 608.01(b).
4. The disclosure is objected to because of the following informalities: On page 29, last line and page 31, line 4, reference is made to "claim 1", however, this claim has already been cancelled and it is not clear whether the limitations of this claim would be the same as the renumbered claim 1, should this application issues as a patent. It is suggested that the recitation to claim 1 be deleted or the limitations of claim 1 be physically incorporated into the specification.

Appropriate correction is required.

5. The rejection of claims 21-40 under 35 U.S.C. 112, first paragraph is withdrawn in view of applicants' amendment.

6. Claim 41 stands rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession

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of the claimed invention. The limitation “gelling additive” in line 2 is nowhere supported in the specification and is considered new matter.

7. The rejection of claims 23, 25 and 40 under 35 U.S.C. 112, second paragraph is withdrawn in view of applicants' amendment.

8. Claims 24, 27-30 and 37 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 24 and 37, the terms “detergents” and “surfactants” read upon one another and therefore do not meet the requirements of 35 USC 112, second paragraph; that is, the members of a Markush group must be mutually exclusive (see *Ex parte Clark*, 174 USPQ 40 (BPAI 1971)). Claims 27-30, being dependent upon claim 24, are rejected as well.

9. The objection to claim 41 is withdrawn in view of applicants' amendment.

10. The rejection of claims 21, 24-28, 31-41 under 35 U.S.C. 102(e) as being anticipated by Addison (US Patent No. 6,274,538), hereinafter “Addison” is withdrawn in view of applicants' arguments.

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11. The rejection of claims 21, 23-28, 31-41 under 35 U.S.C. 102(e) as being anticipated by Painter (US Patent No. 6,303,561), hereinafter "Painter" is withdrawn in view of applicants' arguments.

12. The rejection of claims 22, 23, 29 and 30 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Addison is withdrawn in view of applicants' arguments.

13. *The rejection of*  
Claims 22, 29 and 30 ~~are rejected~~ under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Painter is withdrawn in view of applicants' arguments.

14. The rejection of claims 33-41 under 35 U.S.C. 103(a) as being unpatentable over Gladfelter et al. (WO 92/20774), hereinafter "Gladfelter" is withdrawn in view of applicants' amendment.

15. Claims 21-32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gladfelter for the reasons set forth in the office action in paper number 8.

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16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

17. Claims 21, 23-26, 28, 33, 36-38, 40-44 are rejected under 35 U.S.C. 102(a) as being anticipated by Iwase et al. (JP 09175992), hereinafter “Iwase”.

Iwase teaches bath tablets comprising immobilized encapsulated compounds on the concave circles of the tablet surface wherein once the tablets are placed in a hot bath water, the capsules are separated and dissolved to release liquid active ingredients especially perfumes and herb extracts (see abstract). A mixture containing  $\text{NaHCO}_3$  25,  $\text{Na}_2\text{CO}_3$  24, fumaric acid 40.25, polyethylene glycol 3.5, glucose 5, dextrin 1%, colors and perfumes was placed in a mould and pressed at a gauge pressure of  $200 \text{ kg/cm}^2$  using a punch with a raised part in the center, capsules containing perfumes were placed in concave parts of the tablet, polyoxyethylene(POE)(160)-polyoxypropylene(POP)(30)glycol melted at  $60^\circ\text{C}$  or polyethyleneglycol 1500 melted at  $60^\circ\text{C}$  was added and was cooled for 2 hours at  $25^\circ\text{C}$  and tablets with attached capsules were obtained (see Examples 1 and 4 in section [0045] of the translation). Iwase also teaches that the capsules detach from the tablet as soon as they are placed in bath water (see section [0035] of the translation). Iwase teaches the limitations of the instant claims. Hence, Iwase anticipates the claims.

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18. Claim 22 is rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Iwase.

Iwase teaches the features as described above. Even though Iwase does not explicitly disclose the viscosity of the melt (i.e., the viscosity of polyoxyethylene(POE)(160)-polyoxypropylene(POP)(30)glycol or polyethyleneglycol 1500 when melted) it would be inherent for these compounds to have a viscosity within those recited because same compounds have been utilized. Hence, Iwase anticipates the claim.

19. Claims 27, 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwase as applied to the above claims.

Iwase teaches the features as described above. In addition, Iwase teaches that the tablet may also comprise proteolytic enzymes (see section [0028] of the translation). Iwase, however, fails to specifically disclose the dissolution rate of the tablet.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to reasonably expect the dissolution rate of the tablet of Iwase to be within those recited because similar tablets having similar ingredients have been utilized.

### ***Double Patenting***

20. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

21. Claims 21-33 and 36-44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 31-32, 35, 37 and 39 of copending Application No. **09/446,434**; claims 21, 24-29 of copending Application No. **09/446,436**; claim 25 of copending Application No. **09/446,481**; claims 25, 27, 29, 31-36, 41-42 of copending Application No. **09/446,578**; and claims 43 and 60 of copending Application No. **09/446,579**. Although the conflicting claims are not identical, they are not patentably distinct from each other because all sets of claims are drawn to similar tablets having compressed portions and solidified melt portions having overlapping ranges in the dissolution rate of the tablets.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### *Response to Applicants' Arguments*

22. Applicant's arguments filed June 3, 2002 have been fully considered but they are not persuasive.

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With respect to Gladfelter, Applicants argue that one of skill, reading the claims, would understand a tablet to be a single shape or body as a whole, and not two separable shapes as disclosed in Gladfelter. Applicants also argue that there is no disclosure in Gladfelter which teaches joining a compressed solid with a solidified liquid melt.

The Examiner respectfully disagrees with the above arguments because there is nowhere required in the present claims that the shaped body is a single shaped body. On page 3, lines 16-20; page 7, lines 20-34 and claims 3 and 4, it is clear from Gladfelter that the first shape can be a cast solid, a compressed solid or an extruded solid and the second shape can also be a cast solid, a compressed solid or an extruded solid and this teaching is sufficient motivation to combine a compressed solid with a cast or extruded solid (equivalent to solidified liquid melt).

23. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. These references are considered cumulative to or less material than those discussed above.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is (703) 305-3773. The examiner can normally be reached on Mondays-Fridays from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for this Technology Center is:

(703) 872-9311 - for Official After Final faxes

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(703) 872-9310- for all other Official faxes.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-0661.

August 21, 2002

*Lorna M. Douyon*  
Lorna M. Douyon  
Primary Examiner  
Art Unit 1751